

REMARKS

Claims 1, 5, 17, 22, 25, 26, 80, 84, 90, 91, 101, 102 and 103 have been amended. No new matter has been added.

Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, 80-94, 96, 97, and 99-103 are pending.

CLAIM REJECTIONS

Rejection of claims under 35 U.S.C. §112, second paragraph

The Examiner has rejected claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, 84, 90, 101 and 102 under 35 U.S.C. §112, second paragraph, as being indefinite. See Office Action at p. 3-4. Claims 2-5, 7, 8, 12, 13, 16 and 17 depend from independent claim 1. Claims 25 and 26 depend from independent claim 22.

The Examiner contends that since claims 1, 22 and 102 recite "Y² is CH₂ or a bond," Y² in the last proviso in claims 1, 22 and 102 is undefined when the last limitation is met. See Office Action at p. 3-5. Claims 1, 22 and 102 have been amended to address this concern. Applicants respectfully request withdrawal of this rejection with respect to claims 1, 22 and 102 and dependent claims therefrom.

The Examiner has further rejected claims 5, 17, 26, 84, 90 and 101 for insufficient antecedent basis. See Office Action at p. 4-5. Applicants have amended 5, 17, 26, 84, 90 and 101 to provide sufficient antecedent basis and respectfully request the withdrawal of this rejection with respect to claims 5, 17, 26, 84, 90 and 101.

Rejection of claims under 35 U.S.C. §102(b)

Fleming

The Examiner has rejected claims 1-5, 12, 13, 22 and 102 under 35 U.S.C. § 102(b) as being anticipated by Fleming et al., *Chemical Communications*, 1999, p. 1113-1114 ("Fleming"). See Office Action at p. 5. Claims 2-5, 12 and 13 depend from independent claim 1. Claims 22 and 102 are independent claims.

Specifically, the Examiner contends that "compound 4a, 5-phenyl-pent-2-yneic acid [] corresponds to an instantly claimed compound." See Office Action at p. 5. Applicants respectfully note that while compound 4a is not 5-phenyl-pent-2-yneic acid, related compounds are described in Fleming. In amended claims 1, 22 and 102, when L is C₄ and contains one triple

bond and one double bond or two triple bonds and A is phenyl, Y¹ is not a bond and Y² is not a bond. As such, the compounds described in Fleming are not within the scope of amended claims 1, 22 and 102.

Accordingly, independent claims 1, 22 and 102 and claims that depend therefrom are not anticipated by Fleming for at least the reasons described above. Applicants respectfully request reconsideration and withdrawal of this rejection.

Herold

The Examiner has rejected claims 1-5, 7, 8, 22, 25, 26, 80-86, 89-94, 96, 97, and 100-103 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,010,189 to Herold et al. (“Herold”). See Office Action at p. 5. Claims 2-5, 7 and 8 depend from independent claim 1. Claims 25 and 26 depend from independent claim 22. Claims 81-86, 89 and 90 depend from independent claim 80. Claims 92-94, 96-97 and 100-101 depend from independent claim 91. Claims 102 and 103 are independent claims.

The Examiner contends that compound “6-cyclohexyl-2-phenyl-4-hexenoic acid [] is an instantly claimed compound wherein L is substituted with monocyclic aryl.” See Office Action at p. 5. The Examiner further states that “[s]ince no specific double bond geometry is disclosed the Examiner assumes that both isomers are present.” Id. Applicants respectfully note that the compound described in col. 30, lines 2-7 in Herold is “6-cyclohexyl-2-phenyl-4-hexenoic acid ethyl ester.” Herold does not describe the compound of formula (I) in claims 1, 22, 80, 91, 102 and 103 as those compounds do not include an ethyl ester group. Further, in claims 1, 22, 80, 91, 102 and 103, L is a straight C₃₋₁₂ hydrocarbon chain optionally containing at least one double bond adjacent to Y¹ or Y² (see claims 1 and 22) or L is a straight C₅₋₁₂ hydrocarbon chain containing at least one double bond adjacent to Y¹ or Y² (see claim 80) or L is a straight C₃₋₆ hydrocarbon chain containing at least one double bond adjacent to Y¹ or Y² (see claims 91 and 103) or L is a straight C₃₋₇ hydrocarbon chain optionally containing at least one double bond adjacent to Y¹ or Y² (see claim 102). As such, the compounds described in Herold are not within the scope of claims 1, 22, 80, 91, 102 and 103.

Accordingly, independent claims 1, 22, 80, 91, 102 and 103 and claims that depend therefrom are not anticipated by Herold for at least the reasons described above. Applicants respectfully request reconsideration and withdrawal of this rejection.

Baker

The Examiner has also rejected claims 1-5, 7, 8, 12, 13, 22, 25, 26, 80-90 and 102 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,513,005 to Baker et al. ("Baker"). See Office Action at p. 5-6. Claims 2-5, 7, 8, 12 and 13 depend from independent claim 1. Claims 25 and 26 depend from independent claim 22. Claims 81-90 depend from independent claim 80. Claim 102 is an independent claim.

The Examiner alleges that the "compound (E)-8-phenyloctenoic acid and its aqueous solution corresponding to a pharmaceutical composition" anticipates the claims described above. Id. Baker does not describe the compound of formula (I) in claims 1, 22, 80, 91, 102 and 103. In claims 1, 22, 80, 91, 102 and 103, L is a straight C₃₋₁₂ hydrocarbon chain optionally containing at least one double bond adjacent to Y¹ or Y² (see claims 1 and 22) or L is a straight C₅₋₁₂ hydrocarbon chain containing at least one double bond adjacent to Y¹ or Y² (see claim 80) or L is a straight C₃₋₇ hydrocarbon chain optionally containing at least one double bond adjacent to Y¹ or Y² (see claim 102).

Accordingly, independent claims 1, 22, 80 and 102 and claims that depend therefrom are not anticipated by Baker for at least the reasons described above. Applicants respectfully request reconsideration and withdrawal of this rejection.

CONCLUSION

Applicants believe that the claims now pending are in condition for allowance. Should any fees be required by the present Amendment, the Director is hereby authorized to charge Deposit Account 19-4293.

Respectfully submitted,

Date: 3-5-07
Customer No. 27890
Steptoe & Johnson LLP
1330 Connecticut Avenue, NW
Washington, DC 20036-1795
Phone: 202-429-6748
Fax: 202-429-3902


Harold H. Fox
Reg. No. 41,498